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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,631	02/12/2001	Konstantinos Papathomas	END919990060US1	9523

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/781,631

Applicant(s)

PAPATHOMAS, KONSTANTINOS

Examiner

Margaret G. Moore

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: of reasons noted in the attached paper.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

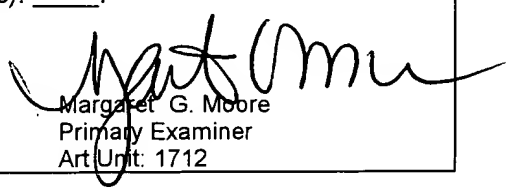
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: see attached PTO-892


Margaret G. Moore
Primary Examiner
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ATTACHMENT:

1) With regards to applicants' belief that the rejection regarding the use of the term "toughness" is based on the fact that these values are not taught by the prior art, this is completely misguided and derogatory. As noted in the previous office actions, this rejection is based on the fact that one cannot determine how the claimed toughness is measured and thus this limitation is neither enabled nor definite. While the Examiner does not believe this to be necessary, she draws applicants' attention to a) Goldberg et al, which teaches that "the various measures to toughness... are tensile strength... and flexibility" on column 11, lines 47 to 55, b) Gallagher et al., which teaches on column 1, lines 60 to 65, that "toughness can be determined by..." and cite specific ASTM tests, c) Kamada et al., which teaches on column 6, lines 35 to 40, a specific test that is used to determine toughness, and d) Tang et al., which teaches on column 14, lines 16 and 17, that fracture toughness is measured by a specific published method. Applicants' previous response states that Tang et al. recites the "standard" for core/shell particles as EP-A 0 578 613, but the Examiner questions what type of "standard" this is. In addition, while column 2 of Tang et al. refers to EP 578 613, it does not refer to using it as a guide for "toughness". In fact Tang et al. refer to the flexural and impact strength in the particles of EP 578 613. The Examiner notes that there is tensile toughness, fracture toughness and various other types of "toughness" that can be measured. Thus she maintains that "toughness" on its own, as found in claims 41, 43 and 48, is indefinite and non-enabled.

The Examiner does not suggest that IBM would use a method that could not be duplicated, as applicants' indicate on page 4 of their response. She is suggesting that one having ordinary skill in the art cannot duplicate this method because one does not know what the method is! While standards for testing toughness are well known, there are many different standards.

2) With regards to applicants' recitation of intended use for the composition claimed, their attention is drawn to MPEP 2111.02, under the topic PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE. To summarize, if the body of a claim fully

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and intrinsically sets forth all of the limitations of the claimed invention and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Applicants' claims are fully defined by the components in the compositions. This intended use does not result in a structurally different composition.

Applicants' statements that Hanyu et al., Usui et al. and Tang et al. do not teach the purpose of the invention doesn't overcome an anticipation or obviousness rejection.

The Examiner cannot find support for applicants statement that "a sole reference not having the same purpose is improperly applied under 35 U.S.C. 102 and 103" on page 7 of their response.

- 3) With regards to applicants' assertion that Hanyu et al. do not teach silica fill, see Example 18 of Hanyu et al.
- 4) With regards to applicants' statement that applicant should be given the same respect that the office gives other applicants and patentees, the Examiner agrees and is giving applicants the same respect that others receive. It is unclear why applicants would think or suggest otherwise.
- 5) With regards to arguments regarding the T_g , crosslinking and hardness in Tang et al., applicants are reminded that there are no "crosslinking" limitations in, for instance, claim 31 and the inner and outer shell T_g limitation claimed is met by Tang et al. These arguments are directed to how applicants obtain their claimed results and do not reflect a difference between what is actually claimed and the prior art.
- 6) With regards to the alleged support for claims 35 and 66, the Examiner cannot find this at the top of page 4. With regards to the alleged support for the materials and percentages in claim 36, page 7 teaches a first polyol in an amount of between approximately 1 and 2, and a second polyol in an amount of between approximately 0 and 1;

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this does not support the claimed amount of between approximately 0 and 2. While the first full paragraph on page 2 contain the word ceramic, this does not support what is claimed. Page 2 states that the invention includes the use of organic substrate materials and that for organic substrates, the CTE must be approximately three times greater than that of ceramic materials. This doesn't support encapsulating an IC chip and a ceramic substrate; in fact, it teaches away from it since it teaches only organic substrates.

7) With regards to applicants' remarks on the second full paragraph on page 7 of their response, it is not clear how these remarks address the objection specifically referring to cycloaliphatic resins, said ceramic substrates and said epoxy resin.

8) With regards to applicants' statement on the top of page 8 that Usui et al. is used for plastic substrates rather than organic substrates, applicants' attention is directed to the basic definition of plastics which begins with "a group of organic materials...". See the attached Grant and Hackh's definition.

9) The Examiner believes she has adequately addressed applicants' traversals. In view of that noted above and that of record, the rejections are maintained. Applicants' assertions of patentability are not persuasive.